

JUN 13 2006

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To: Examiner James A. Reagan Art Unit 3621 U.S. Patent and Trademark Office	Facsimile No. 571-273-8300 Telephone No. 571-272-6710
From: Rebecca Clayton Admin. Assistant to Stephen J. Walder, Jr.	No. of Pages Including Cover Sheet: 9
Please Acknowledge Receipt of the Following Documents Filed Herewith:  (1) Transmittal Document; and  (2) Appellants' Reply Brief (37 C.F.R. 41.41).	
Serial No. 09/884,296; Attorney Docket No. AUS920010620US1	
Date: Tuesday, June 13, 2006	

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In re application of: **Adler et al.**Serial No.: **09/884,296**Filed: **June 19, 2001****For: Using a Privacy Agreement  
Framework to Improve Handling  
of Personally Identifiable  
Information**

50170

PATENT TRADEMARK OFFICE

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§Group Art Unit: **3621**Examiner: **Reagan, James A.**Attorney Docket No.: **AUS920010620US1**Certificate of Transmission Under 37 C.F.R. § 1.8(a)I hereby certify this correspondence is being transmitted via facsimile to the  
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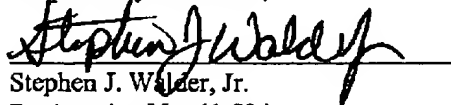
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ENCLOSED HEREWITH:

- Appellants' Reply Brief (37 C.F.R. 41.41)

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Respectfully submitted,



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ATTORNEY FOR APPELLANTS

**Docket No. AUS920010620US1**

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re application of: **Adler et al.**

§ Group Art Unit: **3621**

Serial No. **09/884,296**

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§ Examiner: **Reagan, James A.**

Filed: **June 19, 2001**

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§ Customer No. **50170**

For: **Using a Privacy Agreement  
Framework to Improve Handling of  
Personally Identifiable Information**

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**Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450**

**ATTENTION: Board of Patent Appeals and Interferences**

**APPELLANTS' REPLY BRIEF (37 C.F.R. 41.41)**

This reply brief is in response to the Examiner's Answer mailed April 21, 2006.

The fees required under § 1.17(c), and any required petition for extension of time for filing this brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

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**I. Grouping of Claims**

The Examiner's Answer continues to state that Appellants' Brief does not contain a statement that the claims do not stand or fall together and thus, the claims are considered to stand or fall together. However, the Examiner's Answer now states that claim 2 should be grouped separately.

Appellants respectfully submit that such a stance is improper in view of the Rules of Practice Before the Board of Patent Appeals and Interferences enacted September 13, 2004. Appellants have provided arguments both in Appellants' Appeal Brief and herein in Appellants' Reply Brief, illustrating how each of the claims are directed to patentable subject matter. Arguments are presented for independent claims 1, 6 and 11 under 35 U.S.C. 103(a). Additionally, separate arguments are presented for each of claims 2, 3, 4, and 5, as well as similar dependent claims 7-10 and 13-15 under 35 U.S.C. 103(a). Thus, if any grouping of claims is to be made, it should be as follows:

Group I: claims 1, 6, and 11;

Group II: claims 2, 7, and 12;

Group III: claims 3, 8, and 13;

Group IV: claims 4, 9, and 14; and

Group V: claims 5, 10, and 15.

Accordingly, Appellants respectfully request that the Board of Patent Appeals and Interferences review the rejections of the claims in view of the grounds of rejection set forth in the Final Office Action, the separate arguments presented by Appellants in both Appellants' Appeal Brief and Reply Brief, and the Grouping of Claims set forth above.

**II. Response to Examiner's Remarks Regarding Rejection Under 35 U.S.C. 103**

The arguments presented with regard to the various combinations of the references King, Kroenke and Spies, set forth in Appellants' Appeal Brief and the previously Filed Reply Brief are

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believed to still be applicable to the present rejections in view of the Examiner's Remarks in the latest Examiner's Answer. The following remarks are provided to restate Appellants' position with regard to certain points maintained by the Examiner in the latest Examiner's Answer.

In section 11 of the latest Examiner's Answer, under the title "Issue 2", the Examiner maintains that a suggestion or motivation to combine the King and Kroenke references is present in the references at least at paragraph 007 of King and pages 59+ of Kroenke because both make reference to Business Rules. Appellants have reviewed paragraph 007 of King and do not find any reference to "business rules" in this paragraph of the reference. What is stated is that the exchange of sensitive information may be governed by one or more privacy agreements established between the principle parties, i.e. a client device and a server device. King also states in this paragraph that a proxy server can manage a list of realms that are allowed sensitive information and may be used to negotiate privacy agreements. However, nowhere in this section of King is there any mention of "business rules" as alleged by the Examiner.

At page 59+, the Kroenke reference describes a database schema that consists of tables, relationships, domains and business rules. The business rules are added to the database schema during a data modeling stage. While Kroenke teaches the inclusion of business rules in a database schema, this does not provide any teaching or suggestion to combine Kroenke with King.

King is clearly directed to a system and method for controlling the transfer of sensitive information between a client device and a server device based on established privacy agreements between the client device and the server device. While King mentions privacy agreements and using them to control the transfer of information, nowhere in King is there any teaching or even suggestion to represent parties, data, and privacy agreements graphically in one or more privacy agreement relationship diagrams or that the privacy agreements use a limited number of privacy-related actions concerning the personally identifiable information. The Examiner does not contest this lack of teaching in King and in fact admits that King lacks such teachings. However, contrary to the Examiner's allegations, Kroenke does not teach or suggest these features either.

Kroenke is a general textbook describing database processing, and happens to have a section directed to entity-relationship modeling using a database schema. A number of diagrams are shown for illustrative purposes to explain examples of relationships between entities that may be represented in a database schema. While these diagrams are present in the textbook of

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Kroenke, these diagrams are merely illustrative of examples for explaining the entity relationship model and do not teach or even suggest to generate privacy agreement relationship diagrams to represent parties, data and privacy agreements of a process of handling personally identifiable information. That is, while Kroenke provides diagrams of relationships between entities for explanation of a database schema, there is no actual teaching in Kroenke to take data of a process for handling personally identifiable information, information regarding relationships between pairs of parties in a privacy agreement, and representing this information in a graphical form as one or more privacy agreement relationship diagrams. Thus, neither Kroenke nor King, either taken alone or in combination, teach or suggest representing parties, data and privacy agreements graphically in one or more privacy agreement relationship diagrams, as recited in claims 1, 6 and 11. Furthermore, there is no teaching or suggestion to combine Kroenke and King in the manner alleged by the Examiner.

King and Kroenke are not directed to solving a similar problem using computer implemented methods, despite the allegations made by the Examiner. King is concerned with controlling the transfer of sensitive information between a client device and a server device by using privacy agreements. Kroenke describes a database schema that may be used with the entity-relationship model. These are not the same problem. In fact, there is no discernable problem addressed by Kroenke. Kroenke merely provides an explanation of a database schema. Thus, the Examiner's allegation that King and Kroenke are directed to solving the same problem is erroneous and not supported by the actual teachings of the references.

Moreover, the Examiner's statement that because both references may mention business rules, that somehow they now become combinable, is also a mistaken attempt to support a combination of teachings from non-analogous references. Merely mentioning business rules and that business rules may be added to the database schema in Kroenke does not give any teaching or suggestion to combine Kroenke with King. Many different systems may make use of business rules and yet not be combinable with the system and method described in King. The mere mention of business rules in some later section of Kroenke does not provide any teaching, suggestion, or motivation to combine the concept of generating relationship diagrams, allegedly taught by Kroenke although Appellants disagree for the reasons stated above, with the teachings of King. To the contrary, the Examiner's pointing to "business rules" as a way of linking the references is a mere attempt to support a combination that is based on two non-analogous

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references that do not provide any motivation to combine their features by finding any possible commonality regardless of how irrelevant it is to the features that are allegedly being combined.

Even if the teachings of Kroenke were somehow combinable with the teachings of King, the result still would not be the invention as recited in independent claims 1, 6 and 11. That is, as stated above, neither reference, either alone or in combination, teaches or suggests to represent the entities, data and relationships between entities, of a process of handling personally identifiable information, graphically as one or more privacy agreement relationship diagrams. Thus, any combination of the references, even if such references were somehow possible and a motivation were provided for such a combination, would still not result in all of the features of independent claims 1, 6 and 11 being taught or suggested. Thus, the rejection of claims 1,2, 6, 7, 11 and 12 under 35 U.S.C. 103(a) based on King and Kroenke is improper and should be overturned by the Board of Patent Appeals and Interferences.

With regard to claim 2, the Examiner maintains that Appellants are reading in features from the specification into the claims and thus, the arguments are not persuasive. Appellants respectfully disagree and point to the specification only as exemplary of the features recited in the claim 2. Nowhere in either King or Kroenke is there any teaching or suggestion to map a business process to privacy rules that are to govern the behavior of pairs of parties, as recited in claim 2, or the similar features found in claims 7 and 12. While Kroenke may mention "business rules" and that business rules may be added to a database schema, there is not teaching or suggestion in Kroenke to map business processes to privacy rules of a privacy agreement that govern the behavior of pairs of parties in a process for handling personally identifiable information, as recited in claim 2. Merely teaching that generally, business rules may be added to an entity-relationship model used with a database schema does not provide any teaching or suggestion to perform the specific functionality recited in claim 2.

With regard to the rejection of claims 3-5, 8-10 and 13-15, these dependent claims are distinguished over the alleged combination of references at least for the same reasons as noted above with regard to claims 1, 6 and 11. The Spies reference does not provide any teaching or suggestion to cure the deficiencies noted above with regard to King and Kroenke. Spies teaches yet another field of technology – encryption. Thus, in the rejections of claims 3-5, 8-10 and 13-15, not only is the Examiner attempting to combine the non-analogous King and Kroenke references, but is now adding a third reference, Spies, that is directed to a completely different

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area of technology than King and Kroenke.

Merely because Spies may generally teach to mitigate risk associated with personal, sensitive information by reducing or restricting access to this information, this general teaching does not render the specific features recited in the dependent claims 3-5, 8-10 and 13-15 unpatentable. To the contrary, Spies teaches a specific way in which to reduce access to information – encryption. Nowhere in Spies is there any teaching or suggestion to identify opportunities to reduce privacy-related risks involved in a process of handling personally identifiable information, as recited in claim 3, or the similar features in claims 8 and 13. Moreover, nowhere in Spies is there any teaching or suggestion to identify unnecessary exchanges of data, as recited in claim 4, or the similar features claims 9 and 14. Furthermore, nowhere in Spies is there any teaching or suggestion to identify opportunities to transform data into a less sensitive format, as recited in claim 5, or the similar features in claims 10 and 15. The Examiner merely states that these features are obvious because Spies gives a general concept that one would want to reduce access to information in order to mitigate risk. The Examiner is using a general concept to reject specific features. The general concept does not obviate all specific implementations of the general concept and thus, the general concept in this case does not obviate the specific features recited in claims 3-5, 8-10 and 13-15. The fact is, the references simply do not teach or suggest the specific features recited in these claims, despite the allegations made by the Examiner regarding the general goal of reducing access to information in order to mitigate risk.

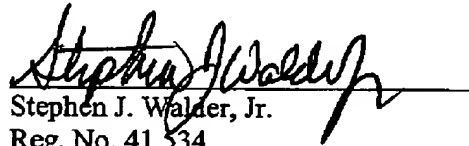
As with the rejection of claims 1, 6 and 11 discussed above, the Examiner's rejections are completely based in a hindsight reconstruction of the claims using non-analogous art from a variety of different fields of technology in an attempt to recreate the claimed invention having first had benefit of Appellants' disclosure. One of ordinary skill in the art would not have found it obvious, without first having benefit of Appellants' disclosure, to combine and modify the teachings of the references in the particular way necessary to arrive at the present claims. The hindsight that is rampant in the rejections made by the Examiner is clear not only from the non-analogous nature of the references sought to be combined, but also in the lack of teachings of these references with regard to the specific features recited in the claims.



### III. Conclusion

In view of the above, Appellants respectfully submit that claims 1-15 of the present application are allowable over the alleged combination of the King, Kroenke, and Spies references. Accordingly, Appellants request that the Board of Patent Appeals and Interferences overturn the rejections set forth in the Final Office Action.

Respectfully submitted,

  
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